

REMARKS

Claims 1, 48 and 50 have been amended to overcome formal objections, withdrawn claims 18-47 canceled without prejudice to introducing them in a child application and the remaining claims presented without amendment.

The office action states:

Claims 1-17 and 48-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 9, the limitation "repeating said selecting" conflicts with the earlier recitation since an "initial firing", as specified in line 5, can only occur once. In claim 48, line 7, the limitation "one or more cylinders" conflicts with subsequent recitations of "cylinders" in the plural. Claim 50 is not clear as to what cylinders are operated simultaneously as specified in lines 6-7. P.3.

Claims 1, 48 and 50 have been amended to overcome the informalities. Accordingly, withdrawal of the rejection of claims 1-17 and 48-52 as indefinite is respectfully requested.

The office action states:

Claim 48 is rejected under 35 U.S.C. 102(e) as being anticipated by Sieber (US 6,799,547 B2). As disclosed at column 7, lines 35-67, cylinder No. 1 and cylinder No. 3 are selected and fired independently of normal operating stroke cycles to the extent required by claim 48, given the broadest reasonable interpretation pursuant to MPEP §§ 2111 and 2111.01. P.3.

This ground of rejection is respectfully traversed.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of

the claimed invention.” *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, “Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim,” 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term “engaging the ball” recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, “Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim.” *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

The claim calls for a starting module that identifies at least one cylinder with piston in a predetermined position range, selects the identified cylinder independently of the normal operating stroke cycles and fires the identified cylinder. The reference does not disclose this claim limitation. Accordingly, withdrawal of the rejection of claim 48 as anticipated by the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the reference regarded as corresponding to the starting module in the last subparagraph of claim 48.

The courtesy of the Examiner in conducting a diligent search is acknowledged with appreciation. The references cited, but not applied, are submitted to be incapable of anticipating, suggesting or making obvious the subject matter as a whole of the invention disclosed in this application.

In view of the forgoing amendments, cancellations and authorities, this application is submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, he is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps he believes are necessary to place the application in a condition for allowance.

Please apply any other charges or credits to deposit account 06-1050, Order No. 02103-452001.

Respectfully submitted,
FISH & RICHARDSON P.C.

Date: 14 November 2005

/charles hieken/
Charles Hieken
Reg. No. 18,411
Attorneys for Application Owner

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906
21205970.doc